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PRE-APPEAL BRIEF REQUEST FOR REVIEW		Docket Number (Optional) 05725.1239-00000
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Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

applicant/inventor.

assignee of record of the entire interest.
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.

attorney or agent of record.
Registration number 65,437.

attorney or agent acting under 37 CFR 1.34.

Sulay D. Jhaveri
Signature

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August 16, 2011
Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required.
Submit multiple forms if more than one signature is required, see below*.

*Total of 1 forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Applicants request a pre-appeal brief panel review of the rejections set forth in the Final Office Action mailed May 17, 2011. Applicants assert that (1) the application has been at least twice rejected; (2) this request is being filed concurrently with a Notice of Appeal under 37 C.F.R. § 41.31; (3) this request is being filed prior to the filing of an Appeal Brief; and (4) this request is five or less pages in length, all in accordance with guidelines set forth in the O.G. Notice of July 12, 2005. No amendments are being filed herewith.

REMARKS

I. Rejections under 35 U.S.C. § 103

The Examiner maintains the rejection of claims 1, 7-13, 15-18, 20-23, 26-27, 33-39, 41-44, 46-56, 59, 83-85, 115 and 119-120 under 35 U.S.C. § 103(a) as allegedly being “unpatentable” over U.S. Patent No. 5,961,998 (“Arnaud”), and being “unpatentable” over Arnaud in view of U.S. Patent No. 6,592,855 (“Willemin”) for the reasons of record. Final Office Action at 3. Moreover, the Examiner states that he “does not find applicants declarations persuasive [because] 1) the declarations do not compare applicants claimed invention to the closest prior art, Arnaud 2) the declarations are not commensurate with the scope of the claims and 3) the declarations do not show unexpected results.” *Id.* at 5. Applicants respectfully disagree and traverse the rejections.

The Examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. See M.P.E.P. § 2142. In *KSR Int'l Co. v. Teleflex Inc.*, 82 U.S.P.Q.2d 1385 (2007), the Supreme Court confirmed that the “framework for applying the statutory language of §103” was still based on its landmark decision in

Graham v. John Deere Co. of Kansas City, 148 U.S.P.Q. 459 (1966). Under *Graham*, there are four factors for consideration when determining whether an invention is obvious: (1) the scope and content of the prior art; (2) the differences between the prior art and the claims at issue; (3) the level of ordinary skill in the art; and (4) secondary considerations. 148 U.S.P.Q. at 467. “Such evidence . . . may include evidence of . . . unexpected results.” M.P.E.P. § 2141. The obviousness or non-obviousness of the claimed invention is then evaluated in view of the results of these inquiries. See *Graham*, 148 U.S.P.Q. 467; *see also KSR*, 82 U.S.P.Q. 2d at 1388. “The key to supporting any rejection under 35 U.S.C. § 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious.” *Id.* As provided in the recent *Examination Guidelines Update: Developments in the Obviousness Inquiry After KSR v. Teleflex*, the Office reminds its personnel that “merely pointing to the presence of all claim elements in the prior art is **not** a complete statement of a rejection for obviousness.” 75 Fed. Reg. 53,643, 53,647 (2010) (emphasis added). The Office further explains that

In accordance with MPEP § 2143A(3), a proper rejection based on the rationale that the claimed invention is a combination of prior art elements **also includes a finding that results flowing from the combination would have been predictable** to a person of ordinary skill in the art. MPEP § 2143A(3). If results would **not** have been predictable, Office personnel should **not** enter an obviousness rejection using the combination of prior art elements rationale, and should **withdraw** such a rejection if it has been made.

Id. (emphases added). In the M.P.E.P., the Office notes that “[i]t can be important to identify a reason that would have prompted a person of ordinary skill in the relevant field

to combine the elements in the way the new invention does.” M.P.E.P. § 2143 A

(quoting *KSR*, 82 U.S.P.Q.2d at 1396 (2007)).

As an initial matter, Arnaud does not teach the claimed composition. Moreover, contrary to the Examiner’s suggestion, Arnaud fails to provide any reason to one of ordinary skill in the art, at the time of invention, to select the specific combination of, *inter alia*, at least one high viscosity phenylsilicone oil chosen from the oils of formula (A), at least one low viscosity phenylsilicone oil having a viscosity of less than 500 cst, and at least one of the eight claimed non-volatile ester oils, with a molecular mass of more than 500 g/mol.¹ Instead, Arnaud provides a long list of optional oils and esters. See Arnaud col. 3, line 25 - col. 4, line 41 and col. 5, line 21, - col. 6, line 13. In this broad disclosure, Arnaud lumps together various oils with no discernment of chemical class or size. Moreover, Arnaud makes no distinction whatsoever between non-volatile ester oils with a molecular mass greater than 500 g/mol and those with a molecular mass less than 500 g/mol to be used in a specific combination with a low viscosity and high viscosity phenylsilicone oil. Thus, Arnaud provides no reason to a person of ordinary skill in the art to combine the oils it discloses in the way the present claims do.

The Examiner’s rejection is based on his assumption that one of ordinary skill in the art would have picked and chosen individual components disclosed in Arnaud to create combinations “with nothing more than predictable results.” See Final Office Action at 3-4. The Examiner has failed to articulate findings of fact that support this

¹ The Examiner’s reliance on the example from Arnaud which contains the claimed ester, tridecyl trimellitate, is inappropriate because the example contains no other oils. The Examiner fails to compare all of the presently claimed elements with the cited art. See M.P.E.P. § 2143.03 (“All claim limitations must be considered”).

assumption. Thus, Applicants maintain that the Examiner has not established a *prima facie* case of obviousness.

The evidence presented in both Declarations² clearly demonstrates that the Examiner's assumption of "predictable results" is in error. The Declarations show results for inventive compositions comprising four different claimed non-volatile ester oils with a molecular mass more than 500 g/mol, and three comparative compositions comprising non-volatile ester oils, with a molecular mass of less than 500 g/mol. See First and Second Declarations, Tables 1-3. Comparative Compositions 2 and 3 in the Second Declaration, prepared with other ester oils recited in Arnaud, and yet outside the scope of the present claims, exhibited a poor level of wear of the glossiness and a poor level of wear of color. See Second Declaration, Table 3. Thus, these tests directly compare the presently claimed compositions to Arnaud, and results are unexpected and show unpredictability in the art.

The Examiner alleges that the results are "garnered through routine and obvious optimization." Final Office Action at 7. This is a mischaracterization. The compositions were evaluated by applicants based on: Hardness, Stability of sticks after 24 hours at various temperatures, Homogeneity of deposit on Bioskin, Texture, Level of wear of glossiness, and Level of wear of color. See, e.g., Second Declaration, pp. 4-7. A person of ordinary skill in the art reading Arnaud, would not recognize that the molecular mass of the non-volatile ester oil, as part of a specific combination of oils, would be a result effective variable for any of these properties. See M.P.E.P. § 2144.05(II)b ("[a] particular parameter must first be recognized as a result-effective variable, i.e., a

² Applicants filed a Declaration of Veronique Ferrari on October 20, 2009 ("First Declaration") and a Declaration of Virginie Nowak on December 1, 2010 ("Second Declaration").

variable which achieves a recognized result, before the determination of the optimum or workable ranges of said variable might be characterized as routine experimentation.”).

Finally, the Examiner’s allegation that the results in the Declarations are not commensurate with the scope of the claims is also unavailing. “Nonobviousness of a genus or claimed range may be supported by data showing unexpected results of a species or narrower range under certain circumstances.” M.P.E.P. §716.02(d)I. In addition to the tests described above with several non-volatile ester oils, Applicants also compared compositions with two different high viscosity phenylsiloxanes. See First Declaration, Table 4. Applicants found that compositions 4 and 6, both prepared in accord with the present claims, were judged to deposit well. See *id.* at 8-12. The results provided in the specification and both Declarations provide enough examples to allow the skilled artisan to determine a trend in the data and reasonably extend the probative value thereof. See M.P.E.P. § 716.02(d)I. Thus the evidence of nonobviousness is commensurate with the scope of the claims.

Accordingly, this rejection over Arnaud is improper and should be withdrawn.

Willemin does not cure the deficiencies of Arnaud discussed above, i.e., it does not offer any guidance to one of ordinary skill in the art to the presently claimed combination of at least one high viscosity phenylsilicone oil chosen from the oils of formula (A), at least one low viscosity phenylsilicone oil having a viscosity of less than 500 cst, and at least one non-volatile ester oil having a molecular mass of greater than 500 g/mol chosen from the specific non-volatile ester oils recited in the present claims. Accordingly, Applicants respectfully submit that this rejection should also be withdrawn.